

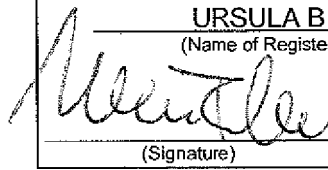
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No.: HEINEMANN-8

In re PATENT Application of:)
JENS HEINEMANN ET AL.)
)
Appl. No.: 10/570,917) Examiner: YIP, KENT
Filed: February 12, 2007)
) Group Art Unit: 2625
For: METHOD AND DEVICE FOR THE)
INDIVIDUAL, LOCATION-INDEPENDENT) Confirmation No.: 3829
DESIGNING OF IMAGES, CARDS AND)
SIMILAR)

**RESPONSE TO OFFICIAL ACTION
dated October 11, 2012**

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATION OF EFS-WEB TRANSMISSION
I hereby certify that this paper is being EFS-Web transmitted to the U.S. Patent and Trademark Office, Alexandria VA 22313-1450, on <u>January 11, 2012</u> .
Date
<u>URSULA B. DAY</u> (Name of Registered Representative)
 (Signature)
<u>Jan 11, 2012</u> (Date of Signature)

S I R:

This communication is in response to the Official Action of October 11, 2011 having a shortened period for response terminating January 10, 2012.

The Commissioner is hereby also authorized to charge any fees which may be required during the pendency of this application, including any patent application processing fees under 37 C.F.R. 1.17, and any filing fees under 37 C.F.R. 1.16, including presentation of extra claims, or credit any overpayment to Deposit Account No: 50-1747.

Please amend the above-entitled application as follows:

**AMENDMENTS TO THE CLAIMS WITH MARKINGS TO SHOW CHANGES
MADE, AND LISTING OF ALL CLAIMS WITH PROPER IDENTIFIERS**

1.-26. (Cancelled)

27. (Currently amended) A method for creating individual pictures, cards and similar items comprising the steps in the following order:
- a) explaining the method to a user on a preview window on a system screen[;] by
 - b) activating a communication and language selection and selecting the language for further transaction by the user and the picture, card or item to be created;
 - c) selecting a motif for the picture, card or item from one or more motifs stored in the system, and embedding the motif in a layout for the picture, card or item; and
 - d) (i) user is viewing himself in a pre-view monitor displaying the user in a mirror image
(ii) creating recording one or more portraits a video sequence of the user by a video camera through video streaming; wherein recording is carried out under a constant LED light source; said camera having an optimization function for presenting a finite number of optimized portraits to the user; wherein the user is selecting an optimized portrait and embedding the optimized portrait in the layout for the picture, card or item;
 - e) integrating a desired text into the layout;
 - f) selecting to print, send or store a ready to output product on the screen after the product is either edited or corrected by repeating at least steps c) to e);
 - g) activating the billing and payment function;
 - h) receiving the outputted finished product.

- 28. (Cancelled)
- 29. (Previously presented) The method according to claim 27, wherein a format is selected which is a DP stream in progressive recording mode.
- 30. (Previously presented) The method of claim 27, wherein the user has an opportunity to select a suitable image through manual selection.
- 31. (Previously presented) The method according to claim 27, wherein the user is offered an interaction element for selecting an individual image.
- 32. (Previously presented) The method of claim 27, wherein during automatic selection, images of optimal quality are selected.
- 33. (Cancelled)
- 34. (Previously presented) The method of claim 27, wherein a user can select from at least four images of the video stream.
- 35. (Previously presented) The method of claim 27, wherein one or more images are displayed for viewing on a screen for preview.
- 36. (Previously presented) The method of claim 27, wherein the finished product is printed out, sent as an e-mail, saved on storage media or saved to an online database offered by the system.
- 37. (Previously presented) The method of claim 36, wherein the layouts are selected from external stationary or mobile media or online databases.

38. (Previously presented) The method of claim 36, wherein transfer means are used for interfacing with internet, wireless connection or external peripheral devices.
39. (Currently amended) An interactive machine for the individual design of pictures, cards, postcards and similar items comprising at least:
- a) a monitor;
 - b) a camera with an adjustment apparatus; wherein the camera has video streaming means and editing means for displaying a mirror image preview image, and means for presenting optimized portraits to a user for selecting one or more of the optimized images;
 - c) a lighting unit;
 - d) means for operating the machine;
 - e) at least one interface for communication with external storage media and internet connection;
 - f) an integrated DP system comprising at least one internal storage unit; wherein the
 - g) an output apparatus for creating at least one of, the picture and the cards;
 - h) a payment unit;
 - i) a postage unit;
 - j) a power supply;
 - k) means for location-independent placement of the machine;
 - l) theft prevention means;
 - m) a remote maintenance unit.
40. (Previously presented) The machine of claim 39, wherein the camera includes a digital video camera for generating a video stream.

41. (Previously presented) The machine of claim 39, wherein the lighting unit includes a photometer and a plurality of LED diodes for generating constant light for illumination of the user.
42. (Previously presented) The machine of claim 39, wherein the monitor is a touch screen monitor.
43. (Previously presented) The machine of claim 39, wherein the machine is operated by at least one of, a keyboard and a joystick.
44. (Previously presented) The machine of claim 39, wherein the output unit is a thermo sublimation printer.
45. (Previously presented) The machine of claim 39, wherein the interface is suitable for various storage media.
46. (Previously presented) The machine of claim 39, wherein additional powers supply in the form of a solar module is provided and for charging batteries.
47. (Previously presented) The machine of claim 39, wherein the machine is provided with wheels, coasters or a carrying appliance.
48. (Previously presented) The machine of claim 39, wherein the theft prevention means include at least one of physical attachment of the machine at the location and radio signals that are acoustically or visually perceptible or via radio.
49. (Previously presented) The machine of claim 39, wherein the remote maintenance unit functions by wireless communications or via cables.

50. (Currently amended) The machine of claim 48, wherein the theft prevention ~~unit~~ means features a motion sensor for the detection of approaching persons.
51. (Previously presented) The machine of claim 39, wherein the machine has surfaces for carrying advertisement that are background illuminated or is an electronic advertising panel.
52. (Previously presented) The method of claim 27, wherein the motif stored in the system is supplied by a kiosk.
53. (Previously presented) The method of claim 27, wherein the motif stored in the system is supplied by the user.

REMARKS

The last Office Action of October 11, 2011 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 27-52 are pending in the application. Claim 33 has been cancelled. Claims 27, 39 and 50 have been amended. A total of 25 claims is now on file. No amendment to the specification has been made. No fee is due.

It is noted that claim 50 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 27, 29-38, 52 and 53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan of record in view of U.S. Pat. No. 6,466,830 to Manross ("Manross") and U.S. Patent No.: 7,098,942 to Nihei ("Nihei").

Claims 38-48, 50 and 52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan of record in view of U.S. Pat. Publication No. US2002/0154327 to Jones ("Jones").

Claim 50 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan of record in view of Jones and U.S. Patent Publication 2004/0085449 (which is a continuation of U.S. patent application of 09/464,221 filed 12/15/1999).

IDS

The Examiner has not yet confirmed that the reference prior submitted on January 4, 2011 has been considered. Applicant respectfully requests such confirmation.

REJECTION OF CLAIM 50 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Examiner's rejection has been rendered moot by the amendment to claim 50, where the term --means-- was inserted instead of "unit".

Withdrawal of the rejection of claim 50 under 35 U.S.C. §112, second paragraph is thus respectfully requested.

REJECTION OF CLAIMS 27, 29-38, 52 AND 53 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER MORGAN IN VIEW OF MANROSS AND NIHEI

Applicant has amended claim 27 and 39 to include the streaming function which is supported by the specification in [0029]. The streaming function of the method and the device provides portraits of the user in a preview screen of a series of entire frame images.

Applicant has also amended claim 27 to clarifying that the language function is chosen at the beginning of the cycle. This amendment is supported by the disclosure in paragraph [0019]-[0020].

Morgan teaches a video camera that can record video images but does not display these images on a preview screen. Paragraph [0062] in Morgan:

[H]owever, embodiments of the present invention can be practised with a camera that takes motion pictures such as would be taken by a camcorder or other device that records active movement. In such a case, it is noted that the control unit and/or the image manipulating device and/or the imaging device could be adapted **to freeze the video image upon command and display the image captured on the display device.**

On the other hand, the “streaming function” of the present invention relates to a display of live video footage of the user from the camera via streaming. The user can position itself for portrait capture while simultaneously observing itself in the video streaming (live video output), such that the scan lines are recorded sequentially without interlacing thus producing a stream of a series of entire frame images

The video camera in Morgan is used to acquire images of the user but only

individual still photos will be shown on the screen. Therefore the streaming function in claims 27 and 39 significantly distinguish from the video images as discussed in Morgan.

Furthermore, the Examiner has taken each function, such as selection of language and payment out of context from the references.

Manross was cited for a language selection screen, while the Nihei reference was cited for the payment option as claimed. The language function step in Manross occurs between a assist-delay function and the payment function, while in the claimed method steps, the payment function is activated with the instruction screen at the beginning of using the kiosk. No payment requirement follows. The pre-payment/payment option is a major step in Manross. As claimed the payment requirement is displayed only after the user has viewed a satisfactory product. Accordingly the language selection option as claimed significantly differs from the Manross reference.

The Nihei reference was cited in combination with Morgan and Manross to show the payment function as claimed. Applicant noted in a prior response that the payment function operates differently and at different junctions during the process in Nihei. However, the Examiner remained with his position stating that in Nihei a fee is only required after the product has been inspected.

First, Nihei is from a different technical field in that the device in Nihei represents as such merely a photo printing device. There are no manipulation steps available for creating a card or other articles whereby a motif is chosen and combined with images that can be captured and can be manipulated by the kiosk's functions without the payment of a dollar in coins first. As such, Nihei and Morgan are of different fields and the person skilled in the art is not inclined to look in the art of printers when creating a kiosk.

Furthermore, Nihei discloses only a coin payment option, clearly making it cumbersome for payment even if the user wishes to use the additional drive since a dollar coin must be inserted, which is checked by the coin machine (col. 5, lines 21-25) and is used as an anti-tampering device as stated in Nihei. After inspection

of the finished product, the user pays the remaining fee in coins. (col. 6, lines 16-19).

In the present invention payment can be done in any way possible. Payment may even be made wireless from the user's bank account. While coin payment is also an option, the system according to the present invention does not require "proof" in the form of a prepayment, that the user is serious about using the image capture function.

Summarizing, the Nihei reference is basically a photo printing device; if more than just photos are desired, a prepayment of a dollar coin is required to ascertain usage of the additional drive, but either payment option is only for coins. It is submitted that the payment in Nihei, both by its type and temporal sequence is distinguishable and does not render obvious the payment function in the presently claimed invention, such that the skilled artisan would definitely not look to Nihei for technical know how in the payment option department.

Based on the foregoing discussion, applicant submits that the combination of Morgan, Manross and Nihei does not render the presently claimed method and device obvious, because each of the functions for which each of the references are cited is patentably distinguishable from those claimed as the foregoing discussion shows. Thus, it is evident that the template approach, whereby references are cited for out of context functions to fulfill the claimed features is based on impermissible hindsight.

Withdrawal of the rejection of claims 27, 29-38, 52 and 53 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

REJECTION OF CLAIMS 39-48, 50 AND 52 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER MORGAN IN VIEW OF JONES AND MILLET

The rejection of claims 39-48, 50 and 52 based on Morgan, Jones and Millet is respectfully traversed.

The Examiner admits that Morgan lacks certain features such as a postage unit. Jones is cited to supply the missing feature. As discussed before, the Jones reference is cited for providing a franking unit postage meter strip with a vanity image of a user. The entire description of the reference appears not only impractical but also illusory since, as the description admits, the printing of postage with one's own portraiture is not allowed.

Morgan lacks the feature of the theft prevention function. The examiner cites Millet for fulfilling that function in that Millet allegedly teaches a motion detector that is to be supplied to Morgan.

The filling in of the missing functions in Morgan with functions found in the additionally cited references shows the hindsight approach used by the Examiner.

Morgan as discussed above is distinguishable from the claimed method and device. Therefore, the claims dependent on claims 27 and 39 include all the features of respectively claims 27 and 39 and thus distinguish over the prior art as cited in the same manner as claims 27 and 39.

Withdrawal of the rejection of claims 27, 29-38, 52 and 53 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

CONCLUSION

Applicant believes that when reconsidering the claims in the light of the above comments, the Examiner will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

None of the references discloses a method and devices for the individual location-independent designing of images, cards and similar having features as set forth in the claims.

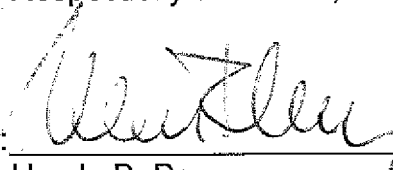
In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

By:


Ursula B. Day
Attorney For Applicant
Reg. No: 47,296

Date: January 11, 2012
708 Third Avenue
Suite 1501
New York, N.Y. 10017
(212)244-5500
UBD:of